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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,995	09/12/2003	Richard W. McCoy	242-129 II CONT III	6100
1009	7590	09/23/2004	EXAMINER	
KING & SCHICKLI, PLLC 247 NORTH BROADWAY LEXINGTON, KY 40507			LUM VANNUCCI, LEE SIN YEE	
			ART UNIT	PAPER NUMBER

3611

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,995

Applicant(s)

MC COY, RICHARD

Examiner

Lee Lum

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. An Amendment was filed 7/2/04.

2. DOUBLE-PATENTING REJECTIONS

A. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 and 12 of U.S. Patent No. 6601868 in view of one of the following patents: McCoy et al 5873594, Horchers 5620198, Kravitz 5511813.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The differences between the Claims in the present *Application*, and the respective Claims in *Patent* 6601868 are minimal as follows:

<u>Present application</u>	<u>6601868</u>	<u>Application does NOT include</u>
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Claim 1	Claim 1	a. "hitch receiver box" b. "brackets being of unitary construction" c. "fore/aft positions"
Claim 10	Claim 12	a. "frame member" b. "hitch box carried on cross member" c. "fore/aft positions"

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Claims 2-9 of both Patent and present Application are identical, and are not addressed.

Re Claim 1 of the *Application*, and the absence of “a hitch receiver box”, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include this feature in the present *Application*, as shown in McCoy ('594), Horchers or Kravitz, to provide connection to a towing vehicle, and as is extremely well-known.

Re Claim 1 of the *Application*, and the absence of “the brackets having unitary construction”, the inventions in McCoy, Horchers and Kravitz, clearly show this characteristic. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include this feature in the present *Application*, as shown in the above-mentioned references, for increased structural integrity, thus providing increased safety in towing operations. This feature also minimizes the number of parts of the assembly, thus decreasing costs and time in manufacturing and assembly.

Re recitations of “fore/aft positions” in the *Patent*, vs. “first/second positions” in the *Application*, it is clear that the latter descriptions in the *Application* are merely broader in scope, and indubitably encompass the former, more specific, language in the *Patent*. These particular positions are clearly depicted in the drawings in BOTH *Patent* and *Application*.

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B. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 6746038 in view of one of the following patents: McCoy et al 5873594, Horchers 5620198, Kravitz 5511813.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The differences between the Claims in the present *Application*, and the respective Claims in *Patent* 6746038 are minimal as follows:

<u>Present application</u>	<u>6746038</u>	<u>Application does NOT include</u>
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Claim 1	Claim 1	"brackets being of unitary construction"
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Claim 10	Claim 10	"cross member", "fore/aft positions"
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Claims 2-9 of both Patent and present Application are identical, and are not addressed.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Re the absence of "the brackets having unitary construction", the inventions in McCoy, Horchers and Kravitz, clearly show this characteristic. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include this feature in the *Application*, as shown in the above-mentioned references, for increased structural integrity, thus providing increased safety in towing operations. This feature also minimizes the number of parts of the assembly, thus decreasing costs and time in manufacturing and assembly.

Re recitations of "fore/aft positions" in the *Patent*, vs. "first/second positions" in the *Application*, it is clear that the latter descriptions in the *Application* are merely broader in scope, and indubitably encompass the former, more specific, language in the *Patent*. These particular positions are clearly depicted in the drawings in both *Patent* and *Application*.

Re "cross member" in the *Patent*, vs. "frame element" in the *Application*, it is clear that the latter recitation is, again, merely broader in scope, and indubitably includes the former, more specific, language in the *Patent*. This particular component is depicted in the drawings in BOTH *Patent* and *Application*.

3. RESPONSE TO REMARKS: Examiner has provided new double-patenting rejections.

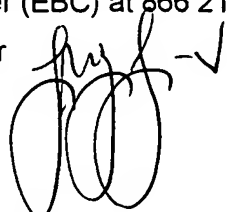
4. The prior art made of record, and not relied upon, is considered pertinent to the disclosure: Helber 5149122.


5. Communication with USPTO/Examiner

Any inquiry concerning this communication, or others, should be directed to Ms. Lum at 703 305-0232, M-F, 9-6. If attempts to reach the examiner are unsuccessful, her supervisor, Ms. Lesley Morris is at 703 308-0629. Our fax number is 703 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications: private PAIR only, for published applications: private or public PAIR. For more information re PAIR: <http://pair-direct.uspto.gov>. Questions re private PAIR: contact the Electronic Business Center (EBC) at 866 217-9197.

Ms. Lee S. Lum, Examiner
9/20/04




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